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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/713,965	11/15/2000	David R. Scott	277-P-32-USA	5189

7590 09/09/2004

Drummond & Duckworth  
5000 Birch Street  
Suite 440 East tower  
Newport Beach, CA 92660

EXAMINER

BLECK, CAROLYN M

ART UNIT	PAPER NUMBER
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3626

DATE MAILED: 09/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/713,965

Applicant(s)

SCOTT, DAVID R.

Examiner

Carolyn M Bleck

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Notice to Applicant*

1. This communication is in response to the application filed 15 November 2000.

Claims 1-7 are pending.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 3, and 5-7 are rejected under 35 U.S.C. 102(b) as being anticipated by Otis (L.H. Otis, *Insured Satellite 'Reboost' is a First*, National Underwriter, vol. 95, issue 16, April 1991, pp. 7-9).

(A) As per claim 1, Otis discloses a method of insuring through coverage for the in-space recovery and "reboost" of a satellite (par. 2) comprising:

(a) acquiring a satellite for orbiting the earth (see discussion of INTELSTAT VI (F-3) for providing worldwide telecommunications services) (par. 3-4); and

(b) obtaining a risk management package encompassing two separate but overlapping coverages in one policy, wherein the first portion of the coverage insures the satellite in low orbit and until its recovery by the NASA space shuttle, and wherein

the second phase of coverage encompasses the operation of placing the satellite into the cargo hold of the space shuttle, refitting it with a new perigee motor, and the reboost of it into its final operational orbit (par. 7-8).

(B) As per claim 3, Otis discloses launching a satellite into a non-operational lower orbit and initiating a rescue/ recovery mission to move the satellite from a non-operational lower orbit to a final operational orbit (par. 2-8).

(C) As per claim 5, Otis discloses a method of insuring through coverage for the in-space recovery and "reboost" of a satellite (par. 2) comprising:

(a) acquiring a satellite for orbiting the earth (see discussion of INTELSTAT VI (F-3) for providing worldwide telecommunications services) (par. 3-4);

(b) obtaining a risk management package encompassing two separate but overlapping coverages in one policy from a guarantor (see Corroon & Black Inspace), wherein the first portion of the coverage insures the satellite in low orbit and until its recovery by the NASA space shuttle, and wherein the second phase of coverage encompasses the operation of placing the satellite into the cargo hold of the space shuttle, refitting it with a new perigee motor, and the reboost of it into its final operational orbit (par. 5, 7-8); and

(c) providing coverage for 180 days after reboost to determine whether the satellite, including its batteries, are working properly, wherein once the satellite has been operation for six months the risk management package will be concluded which

makes for a full term of coverage, wherein during that period any cause of failure is part of the risk package, such as failure to move the satellite into final operational orbit (par. 4-12).

(D) As per claim 6, Otis discloses launching a satellite into a non-operational lower orbit and initiating a rescue/ recovery mission to move the satellite from a non-operational lower orbit to a final operational orbit (par. 2-8) and providing coverage for 180 days after reboost to determine whether the satellite, including its batteries, are working properly, wherein once the satellite has been operation for six months the risk management package will be concluded which makes for a full term of coverage, wherein during that period any cause of failure is part of the risk package, such as failure to move the satellite into final operational orbit, wherein if there is a failure, money is paid for the loss of the satellite (see \$170 million per risk in par. 22-23) (par. 4-12, 21-23).

(E) Claim 7 appears to be a combination of elements from claims 1, 3, and 6, and is therefore rejected for the same reasons given for those claims, and incorporated herein.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 2 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Otis (L.H. Otis, *Insured Satellite 'Reboost' is a First*, National Underwriter, vol. 95, issue 16, April 1991, pp. 7-9) as applied to claim 1, and further in view of Scott (5,806,802).

(A) As per claim 2, Otis discloses insurance coverage for the operation of placing the satellite into the cargo hold of the space shuttle, refitting it with a new perigee motor, and the reboost of it into its final operational orbit (par. 7-8)

Otis fails to expressly disclose the provision for the guarantor initiating a recovery mission including "providing for moving an unmanned extension spacecraft within proximity of the orbiting satellite, mechanically connecting the extension spacecraft to the orbiting satellite to form a docked satellite-spacecraft combination, and moving the satellite-spacecraft combination using the control systems of the extension spacecraft".

Scott discloses providing for launching a SIRE spacecraft, which is unmanned, from earth within proximity of the orbiting satellite, docking the SIRE spacecraft with the target satellite to create a docked combination, and moving the combination using control system of the SIRE spacecraft (Fig. 1-4b, col. 1 lines 22-33, col. 6 line 63 to col. 8 line 33).

At the time the invention was made, it would have been obvious to include the aforementioned features of Scott within the method of Otis with the motivation of extending the life of orbiting satellite and reducing the risk and expense of operations for repairing satellites (Scott; col. 1 lines 47-63).

(B) As per claim 4, Otis fails to expressly disclose moving an unmanned extension spacecraft within proximity of the orbiting satellite, mechanically connecting the extension spacecraft to the orbiting satellite to form a docked satellite-spacecraft combination, and moving the satellite-spacecraft combination using the control systems of the extension spacecraft.

Scott discloses providing for launching a SIRE spacecraft, which is unmanned, from earth within proximity of the orbiting satellite, docking the SIRE spacecraft with the target satellite to create a docked combination, and moving the combination using control system of the SIRE spacecraft (Fig. 1-5 and 8, col. 1 lines 22-33, col. 6 line 63 to col. 8 line 33).

At the time the invention was made, it would have been obvious to include the aforementioned features of Scott within the method of Otis with the motivation of extending the life of orbiting satellite and reducing the risk and expense of operations for repairing satellites (Scott; col. 1 lines 47-63).

### ***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure. The cited but not applied prior art teaches Space insurance industry is seeking greater says in satellite technology (Large), insurance firms hire NASA to find two lost satellites (Wall Street Journal), are you prepared for disaster

(Schwartz), GSA extends, expands satellite communications contract (Dukart), and used satellites, anyone? (International Insurance Monitor).

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carolyn Bleck whose telephone number is (703) 305-3981. The Examiner can normally be reached on Monday-Thursday, 8:00am – 5:30pm, and from 8:30am – 5:00pm on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached at (703) 305-9588.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703) 306-1113.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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**8. Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

**Or faxed to:**

(703) 872-9306 or (703) 872-9326 [Official communications]

(703) 872-9327 [After Final communications labeled "Box AF"]

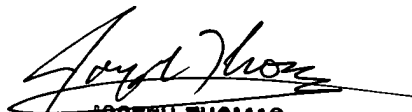
(703) 746-8374 [Informal/ Draft communications, labeled  
"PROPOSED" or "DRAFT"]

Hand-delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive,  
Arlington, VA, 7th Floor (Receptionist).

*CB*

CB

September 7, 2004

  
JOSEPH THOMAS  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600